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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,381	09/20/2005	Eisuke Sasaoka	50212-631	6952
20277	7590	09/28/2006	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			LEPISTO, RYAN A	
			ART UNIT	PAPER NUMBER
			2883	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/519,381	SASAOKA ET AL.
	Examiner Ryan Lepisto	Art Unit 2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,8 and 17-19 is/are rejected.
- 7) Claim(s) 7,17 and 19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 December 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/20/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21 August 2006.

Information Disclosure Statement

The listing of references in the specification on pages 3 and 4 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claims 17 and 19 are objected to because of the following informalities: The dependencies to claims 9 and 12 should be removed since these claims are withdrawn. Appropriate correction is required.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: On page 35 (an maybe other places) the graphs labeled 1020, 1030, etc should be labeled G1020, G1030, etc. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 2b. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 5 and 19 are objected to because of the following informalities: Each of these claims states a range as being a value or more but a second value or less. As it

reads now this could be interpreted to include every value possible since one range is open-ended to higher values and the other is open-ended to lower values. Suggested claim language would be, "have a dispersion wavelength in the range of 1300 nm to 1324 nm." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bickham et al (US 2003/0174988 A1)** (Bickham). Bickham teaches a silica glass optical fiber having a core (not containing germania, paragraph 0095)) and cladding have the following properties: a transmission loss at 1380 nm is preferably less than about 0.1 dB/km (paragraph 0017), a transmission loss at 1310 nm being the same as the attenuation at 1380 nm or within 0.05 dB/km the transmission loss at 1380 nm or the transmission loss at 1380 is lower than the transmission loss at 1310 nm (paragraph 0017), a mode field diameter at 1310 nm of 6.5 to 6.7 μm (Table 2), a chromatic dispersion at 1550 nm between 5 and 9 ps/nm/km (paragraph 0010), a dispersion slope at 1550 nm is less than about 0.042 ps/nm²/km (paragraph 0013), a cable cutoff

of less than 1240 nm (paragraph 0014), a transmission loss at 1550 nm of less than about 0.02 dB/km (paragraph 0016), the difference between transmission loss at 1550 nm and at 1310 nm being between 0.1 to 0.4 (from the values in paragraph 0017), polarization mode dispersion at 1550 nm of less than about 0.04 ps/km^{1/2} (paragraph 0018), a core outer diameter of between 6 and 10 μm (paragraph 0024), a refractive index difference between the core and cladding of between 0.1% to 0.6% (from the values in paragraphs 0023 and 0030, which is the difference between the core and the outer cladding), loss due to OH induced water peaks at 1380 nm being virtually eliminated (paragraph 0112), a measured zero dispersion wavelength of between 1308 and 1316 nm (Table 2) and a dispersion slope at 1400 nm (which is in the preferable zero dispersion wavelength range (0010)) of 0.037 to 0.039 ps/nm²/km (Table 2).

Prior art which teaches a range within, overlapping, or touching the claimed range anticipates if the prior art range discloses the claimed range with sufficient specificity. When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute

an anticipation of the claims. The unexpected results may also render the claims unobvious. The question of "sufficient specificity" is similar to that of "clearly envisaging" a species from a generic teaching. See MPEP § 2131.02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham as applied to claims 1-3, 5-6 and 19 above, and further in view of **Sasaoka et al (US 6,345,140 B1)** (Sasaoka).

Bickham teaches the fiber previously discussed.

Bickham does not teach expressly the value of the Petermann-I mode field diameter.

Sasaoka teaches that the Petermann-I mode field diameter is related to the mode field diameter by the known equations 1a and 1b (column 1 lines 52-59).

Bickham and Sasaoka are analogous art because they are from the same field of endeavor, optical fibers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the fiber taught by Bickham will have a Petermann-I mode field

diameter less than 10 μ m using the equations provided by Sasaoka since Bickham teaches a mode field diameter at 1550 nm of 7.5 to 7.7 μ m (Table 2).

The motivation for doing so would have been to have a better way to described the mode field diameter of the fiber while including the relationship of the electric field amplitude and a positional variable (Sasaoka, column 1 lines 52-65).

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Further, it has been held that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). For more recent cases applying this principle, see *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham as applied to claims 1-3, 5-6 and 19 above, and further in view of **Kato et al (US 6,266,467 B1)** (Kato).

Bickham teaches the fiber previously discussed.

Bickham does not teach expressly the cladding doped with fluorine.

Kato teaches a fiber having a fluorine doped cladding (column 27 lines 4-17).

Bickham and Kato are analogous art because they are from the same field of endeavor, optical fibers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to dope the cladding with fluorine since Bickham teaches it is known to diffuse dopants during manufacturing to round the corners of index profiles of his invention (paragraph 0127).

The motivation for doing so would have been to be able to enhance refractive index differences between layers will still allowing relatively easy manufacturing methods (Kato, column 27 lines 15-17).

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: This claim would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims because the latter, either alone or in combination, does not disclose nor render obvious an optical fiber mainly comprising silica glass having the combination of

numerical property limitations giving the claim, in combination with the rest of the claimed limitations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All of the following references teach many of the limitations of applicant's claims: Takahashi et al (US 2004/0136668 A1), Oliveti et al (US 2004/0033039 A1), Tsukitani et al (US 2003/0147610).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Lepisto whose telephone number is (571) 272-1946. The examiner can normally be reached on M-Th 7:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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